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FARJAMI & FARJAMI LLP
26522 LA ALAMEDA AVENUE, SUITE 360
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SEP 23 2004

In re Application of :
Ogle, et al. :
Application No. 10/010,280 :
Filed: December 5, 2001 :
Attorney Docket No. 0180163 :
For: PRETREATMENT OF ONO LAYER FOR
FLASH MEMORY :

**OFFICE OF PETITIONS
ON PETITION**

This is a decision on the petition under 37 CFR 1.137(a) and, in the alternative, under 37 CFR 1.137(b) to revive the above-identified application. Both petitions were filed in the same paper on April 19, 2004 (certificate of mailing date April 15, 2004).

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The above-identified application became abandoned for failure to properly reply to the final Office action, mailed November 29, 2002. Petitioners filed an amendment after final on February 11, 2003. The amendment after final failed was misplaced and petitioner had to re-submit the amendment on April 23, 2004. The examiner of record reviewed the amendment after final and determined that it did not place the application in *prima facie* condition for allowance, as was explained in the March 17, 2004, an Advisory Action.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof; (2) the petition fee as set forth in § 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section. This petition does not satisfy requirement (3).

Regarding (3), the showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only

where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 USC § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term 'unavoidable' "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

In the instant case, petitioners have failed to provide adequate evidence that the delay was unavoidable. Petitioners assert that the entire delay was caused by the PTO misplacing the February 11, 2003 amendment after final. This resulted in the amendment being reviewed and not entered *after* the extendable period for reply had expired. Thus, petitioners argue they were unavoidably delayed from filing a timely and proper reply because they did not receive an Advisory Action until after the period of reply had expired.

Petitioners are reminded that after a final action, there are only five possible replies: (1) a Notice of Appeal, (2) the filing of a continuing application, (3) a 37 CFR 1.129(a) submission, if appropriate, (4) an amendment after final that makes the case ready for issuance or (4) an RCE. To be a proper reply, an amendment after final must eliminate all of the Examiner's objections and rejections, and thus place the case in *prima facie* condition for allowance.

Petitioners' amendment after final failed to eliminate all of the Examiner's objections and rejections, as was stated in the Advisory Action of March 17, 2004.

The rules of practice are clear that prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last Office action, or refusal to admit the same, shall not operate to save the application from abandonment. "[T]he admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to

appeal or to save the application from abandonment under § 1.135." See 37 CFR 1.116(a).

Petitioners are reminded that an Advisory Action is mailed as a courtesy and does not start a new period for response. The application became abandoned because petitioners did not submit a proper reply to the final Office action.

The abandonment of an application subject to a final Office action is not "unavoidable" within the meaning of 35 USC 133 and 37 CFR 1.137(a) in the situation in which the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a Notice of Allowance or other action. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. At 53162, 1203 Off. Gaz. Pat. Office at 89 (response to comment 66).

While the misplacement of the February 11, 2003 amendment after final is unfortunate, it does not shift the burden of ensuring that a proper reply is timely filed from the applicant to the PTO.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

Petitioners request revival under the unintentional standard of 37 CFR 1.137(b) in the alternative.

Petitioners have submitted (1) an amendment, dated March 24, 2004, which places the application in *prima facie* condition for allowance, (2) an acceptable statement regarding the unintentional delay that resulted in abandonment, and (3) the petition fee.¹

The petition under 37 CFR 1.137(b) is **GRANTED**.

After the mailing of this decision, the application will be returned to Technology Center Art Unit 2814.

Telephone inquiries pertaining to this matter may be directed to the undersigned at (703) 308-6712. Please call (571) 272-3230 after September 27, 2004.



E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

¹ Petitioners' deposit account will be charged the current large entity 1.137(b) petition fee - \$1,330.00.